

## Remarks

Upon entry of the above amendment, claims 1-9, 19-23, 30 and 39-43 will be pending in the instant application. Claims 1, 39, 40, 41, 42 and 43 are independent. Applicants have canceled claims 10-18, 24-29, 31-32, and 37-38 without prejudice to the subject matter contained therein. Applicants reserve the right to file Continuation Applications to capture the cancelled subject matter. The experimental section (Examples 24, 27, 37, 79 and 80) of the specification provides support for new independent claims 39-43.

### Telephone Interview with Examiner Kumar

Applicants would like to thank Examiner Kumar for the courtesy of a telephonic interview on February 2, 2009 with Applicants' attorneys. The rejections under 35 U.S.C. §112, first paragraph and §103(a) and the claims as presented herein were discussed during the interview.

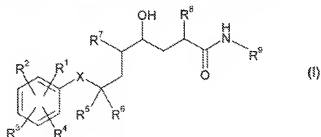
### Issue Under 35 U.S.C. §112, first paragraph

Claim 29 stands rejected under 35 U.S.C. §112 first paragraph as allegedly failing to comply with the enablement requirement. Applicants respectfully traverse this assertion, however in the interest of expediting prosecution Applicants have cancelled claim 29, without prejudice. Therefore, this rejection of claim 29 under 35 U.S.C. §112 is moot.

### Issue Under 35 U.S.C. §103(a)

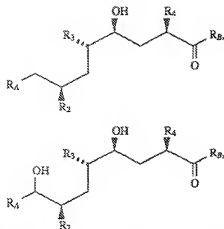
Claims 1-32 and 37-38 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over the combined teachings of Rahuel *et al.* (Chemistry and Biology, 2000, Vol 7, No. 7, pages 493-504) and Goschke *et al.* (US 5,606,078). Applicants respectfully traverse this assertion. Solely for the purposes of expediting prosecution, Applicants have cancelled claims 10-18, 24-29, 31-32 and 37-38, thereby rendering the rejection of these claims moot.

The claimed invention is directed to compounds of formula (I)

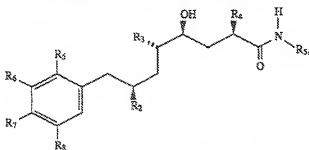


wherein R<sup>9</sup> is optionally substituted cycloalkyl.

Rahuel *et al.* describe compounds wherein the group corresponding to Applicants' group R<sup>9</sup> is butyl or 2,2-dimethyl propylamide (see, *e.g.* Table 1, page 495). Goschke *et al.* describe genres encompassing a broad range of compounds



wherein the  $R_A$  is "an aromatic or heteroaromatic radical" and  $R_B$  is "an aliphatically, cycloaliphatically or heteroaromatically-aliphatically substituted amino group" and



wherein  $R_5$  is "hydrogen, hydroxy, lower alkoxy, cycloalkoxy, lower alkoxy-lower alkoxy or free or esterified or amidated carboxy-lower alkoxy" (see, e.g. column 5).

Applicants respectfully submit that Rahuel *et al.* neither disclose nor suggest compounds wherein the group corresponding to Applicants' group  $R^9$  is optionally substituted cycloalkyl. Goschke *et al.* fail to remedy this defect.

"[I]n order to find a *prima facie* case of unpatentability in such instances [i.e., in chemical cases], a showing that the 'prior art would have suggested making the specific molecular modifications necessary to achieve the claimed invention' was also required..." and that "...in cases involving new chemical compounds, it remains *necessary* to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish *prima facie* obviousness of a new claimed compound." (Takeda Chemical Industries, Ltd. v. Alphapharm PTY., Ltd. 83 U.S.P.Q.2D 1169 (Fed. Cir. 2007)). According to the Court in Eisai v. Dr. Reddy's Laboratories (533 F.3d 1353 (Fed. Cir. 2008)), "post-KSR, a *prima facie* case of obviousness for a chemical compound still, in general, begins with a reasoned identification of a lead compound."

Rahuel *et al.* or Goschke *et al.* fail to provide the needed "motivation," which would have led one of ordinary skill in the art to modify a known compound in a particular manner, e.g., replace a butyl or 2,2-dimethyl propylamide group with an optionally substituted cycloalkyl group.

Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection.

Conclusion

Applicants have addressed each and every issue set forth by the Examiner. Applicants respectfully submit that the present application is in good condition for allowance.

If the Examiner believes for any reason that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (617) 871-4125.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 50-4409 for any additional fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly extension of time fees.

Respectfully submitted,

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